

ESTTA Tracking number: **ESTTA381467**

Filing date: **12/01/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	PRL USA HOLDINGS, INC.
Granted to Date of previous extension	12/01/2010
Address	103 FOULK ROAD WILMINGTON, DE 19803 UNITED STATES
Attorney information	G. Roxanne Elings Greenberg Traurig LLP 200 Park Avenue New York, NY 10166 UNITED STATES nytmkt@gtlaw.com, elingsr@gtlaw.com, dallavala@gtlaw.com, biancoc@gtlaw.com, falbyo@gtlaw.com Phone: 212.801.9200

Applicant Information

Application No	77962017	Publication date	08/03/2010
Opposition Filing Date	12/01/2010	Opposition Period Ends	12/01/2010
Applicant	United States Polo Association, Inc. 771 Corporate Drive Suite 430 Lexington, KY 40503 UNITED STATES		

Goods/Services Affected by Opposition


Class 025. All goods and services in the class are opposed, namely: Belts; Bottoms; Coats; Footwear; Headwear; Jackets; Shorts; Sweat pants; Swimwear; Ties; Tops; Wearable garments and clothing, namely, shirts
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	3470318	Application Date	04/11/2007
Registration Date	07/22/2008	Foreign Priority Date	NONE

Word Mark	NONE
Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 2007/01/00 First Use In Commerce: 2007/01/00 Knit shirts, rugby shirts not specifically adapted to be worn while playing rugby, jackets


U.S. Application No.	77670397	Application Date	02/13/2009
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of two horses with two riders galloping side-by-side.		
Goods/Services	Class 025. First use: First Use: 2008/06/25 First Use In Commerce: 2008/06/25 Knit shirts; Sweaters		


U.S. Application No.	85094272	Application Date	07/27/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	The mark consists of a polo player riding a horse all in the color pink.
Goods/Services	Class 025. First use: First Use: 2001/03/00 First Use In Commerce: 2001/03/00 Clothing, namely, women's shirts, t-shirts, tank tops, pants, hooded sweatshirts, shorts, dresses, leggings and sweatshirts; men's knit shirts; girl's t-shirts, girl's knit shirts and hooded sweatshirts; caps


U.S. Registration No.	3199839	Application Date	09/06/2002
Registration Date	01/16/2007	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a polo player symbol in the color of pink.		
Goods/Services	Class 025. First use: First Use: 2001/03/01 First Use In Commerce: 2001/03/01 WEARING APPAREL, NAMELY, JACKETS, SWEATSHIRTS, SWEAT PANTS, HATS, SCARVES, JERSEYS, JEANS, TURTLENECKS AND BIKINIS		


U.S. Registration No.	3076806	Application Date	06/14/2005
Registration Date	04/04/2006	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	The mark consists of a polo player riding a horse.
Goods/Services	Class 003. First use: First Use: 2002/09/00 First Use In Commerce: 2002/09/00 shower gel, body moisturizer, personal soap and 2 in 1 shampoo and conditioner


U.S. Registration No.	1448580	Application Date	12/04/1986
Registration Date	07/21/1987	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 024. First use: First Use: 1983/10/01 First Use In Commerce: 1983/10/01 TOWELS, SHEETS, PILLOW CASES, PILLOW SHAMS, BED SKIRTS, COMFORTERS, BLANKETS, COMFORTER AND BLANKET COVERS, SHOWER CURTAINS, TABLECLOTHS, NAPKINS, TEXTILE PLACEMATS AND FABRICS FOR HOUSEWARES		


U.S. Registration No.	2052315	Application Date	02/13/1996
Registration Date	04/15/1997	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 018. First use: First Use: 1975/12/30 First Use In Commerce: 1975/12/30 clutches, shoulder bags, cosmetic bags sold empty, tote bags, saddle bags, backpacks, gym bags, duffle bags, travel bags, roll bags, sling bags, grooming kits sold empty, suit bags, tie cases, satchels, pole bags, garment bags for travel, coin purses, drawstring pouches, overnight bags, wallets and key cases


U.S. Registration No.	3812741	Application Date	04/17/2009
Registration Date	07/06/2010	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of the figure of a person mounted on a horse holding a polo mallet in the right hand extended above the person's head.		
Goods/Services	Class 025. First use: First Use: 1976/12/00 First Use In Commerce: 1976/12/00 A full line of clothing		


U.S. Registration No.	2823094	Application Date	09/03/2002
Registration Date	03/16/2004	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	The mark consists of a polo player symbol in the color of pink.
Goods/Services	Class 018. First use: First Use: 2000/09/01 First Use In Commerce: 2000/09/01 TOTE BAGS Class 025. First use: First Use: 2000/09/01 First Use In Commerce: 2000/09/01 WEARING APPAREL, NAMELY, SWEATERS AND T-SHIRTS


U.S. Registration No.	2013947	Application Date	01/05/1996
Registration Date	11/05/1996	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1994/12/06 First Use In Commerce: 1994/12/06 infants and childrens clothing, namely, layettes, cloth bibs, slippers, sleepwear, underwear, rompers, shorts, shirts, coveralls, pants, socks, booties		

U.S. Registration No.	2085471	Application Date	02/20/1996
Registration Date	08/05/1997	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1995/11/01 First Use In Commerce: 1995/11/01 providing information in the field of fashion, fragrance, lifestyle and other topics of general interest by means of a global computer network

U.S. Registration No.	1485359	Application Date	08/03/1987
Registration Date	04/19/1988	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1977/00/00 First Use In Commerce: 1977/00/00 MENS', WOMENS', CHILDRENS' AND ATHLETIC SHOES		

U.S. Registration No.	1212060	Application Date	06/01/1978
Registration Date	10/12/1982	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 1978/02/08 First Use In Commerce: 1978/02/08 Cologne, Aftershave, Aftershave Balm, Antiperspirant, Toilet Soap, [Talcum Powder], Toilet Water, [Body Lotion, Bath Oil, Body Powder and Perfume]

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	The mark consists of the side view images of more than one polo player mounted on horses actively engaged in playing the sport of polo.		
Goods/Services	Apparel		

Attachments	77154087#TMSN.jpeg (1 page)(bytes) 77670397#TMSN.jpeg (1 page)(bytes) 85094272#TMSN.jpeg (1 page)(bytes) 78977703#TMSN.gif (1 page)(bytes) 78650253#TMSN.gif (1 page)(bytes) 73633668#TMSN.gif (1 page)(bytes) 75057170#TMSN.gif (1 page)(bytes) 77716387#TMSN.jpeg (1 page)(bytes) 78160200#TMSN.gif (1 page)(bytes) 75042406#TMSN.gif (1 page)(bytes) 75060269#TMSN.gif (1 page)(bytes) 73676457#TMSN.gif (1 page)(bytes) 73172604#TMSN.gif (1 page)(bytes) USPA Polo Match Opposition 2.pdf (10 pages)(180790 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/GRE/
Name	G. Roxanne Elings
Date	12/01/2010

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re: **U.S. Application Serial No. 77962017**

Mark:



Published: **August 3, 2010**

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PRL USA HOLDINGS, INC.,

Opposition No.

Opposer,

-against-

UNITED STATES POLO ASSOCIATION, INC.

Applicant.

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PRL USA Holdings, Inc. (“PRL” or “Opposer”) believes that it will be damaged by the registration of the above-identified trademark, hereby opposes the registration thereof and alleges as follows:

FACTS

1. Upon information and belief, United States Polo Association, Inc. (“Applicant”) is a corporation, organized and existing under the laws of the state of Illinois, having a place of business at 771 Corporate Drive, Suite 430, Lexington, KY 40503.

2. On or about March 18, 2010, Applicant filed Application Serial No. 77962017,



pursuant to Section 1(b) of the Lanham Act, 15 U.S.C. §1051(b), to register

(“Applicant’s Mark”), for use on or in connection with the following goods (the “Application”):

Class 25: Belts; Bottoms; Coats; Footwear; Headwear; Jackets; Shorts; Sweat pants; Swimwear; Ties; Tops; Wearable garments and clothing, namely, shirts.

3. On or about August 3, 2010, Applicant’s Mark was published for opposition in the Official Trademark Gazette.


4. Upon information and belief, Applicant has not yet commenced use in commerce of Applicant’s Mark.

5. PRL is a corporation organized and existing under the laws of the state of Delaware, having a place of business at 103 Foulk Road, Wilmington, Delaware 19803.

6. PRL is engaged in the manufacture, promotion and distribution of premium lifestyle products in apparel, home, accessories and fragrances.

7. For more than forty (40) years, PRL’s reputation and distinctive image have been consistently developed across an expanding number of products and international markets.

8. As a result, PRL has become one of the top ten largest and most successful apparel companies in the United States.

9. PRL has extensively used the following fanciful representation of a polo player mounted on a horse engaged in playing the sport of polo:  (the “Polo Player Symbol”) to identify and distinguish its goods and services in the marketplace.



10. PRL first began using the Polo Player Symbol since at least as early as 1972 in connection with apparel goods, including, but not limited to, shirts. Today, the Polo Player

Symbol is being used on or in connection with a wide variety goods, including, but not limited to, apparel, footwear, cosmetics, jewelry, and home furnishings.






11. Beginning at least as early as 2007, PRL commenced using one or more of the designs depicted below on or in connection with apparel goods (the “Polo Match Designs”)¹. The designs comprise and incorporate the side view images of polo players mounted on horses actively engaged in playing the sport of polo. The Polo Match Designs capture the essence of the famous Polo Player Symbol and create a similar commercial impression.









12. PRL is the owner of the following applications and valid and subsisting United States Trademark Registrations for the Polo Player Mark on the Principal Register -- some of which are incontestable:

TRADEMARK	APP/ REG. DATE	APP/ REG. NO.	GOODS/SERVICES
	July 22, 2008	3470318	Knit shirts, rugby shirts not specifically adapted to be worn while playing rugby, jackets.
	February 13, 2009	77670397	Knit shirts; Sweaters.

¹ The Polo Player Symbol and the Polo Match Designs are collectively referred to herein as the Polo Player Mark.

TRADEMARK	APP/ REG. DATE	APP/ REG. NO.	GOODS/SERVICES
	July 27, 2010	85094272	Clothing, namely, women's shirts, t-shirts, tank tops, pants, hooded sweatshirts, shorts, dresses, leggings and sweatshirts; men's knit shirts; girl's t-shirts, girl's knit shirts and hooded sweatshirts; caps.
	January 16, 2007	3199839	Wearing apparel, namely, jackets, sweatshirts, sweat pants, hats, scarves, jerseys, jeans, turtlenecks and bikinis
	April 4, 2006	3076806	Shower gel, body moisturizer, personal soap and 2 in 1 shampoo and conditioner.
	July 21, 1987	1448580	Towels, sheets, pillow cases, pillow shams, bed skirts, comforters, blankets, comforter and blanket covers, shower curtains, tablecloths, napkins, textile placemats and fabrics for housewares.
	July 6, 2010	3812741	A full line of clothing.

TRADEMARK	APP/ REG. DATE	APP/ REG. NO.	GOODS/SERVICES
	March 16, 2004	2823094	Tote bags
	April 15, 1997	2052315	Clutches, shoulder bags, cosmetic bags sold empty, tote bags, saddle bags, backpacks, gym bags, duffle bags, travel bags, roll bags, sling bags, grooming kits sold empty, suit bags, tie cases, satchels, pole bags, garment bags for travel, coin purses, drawstring pouches, overnight bags, wallets and key cases
	November 5, 1996	2013947	Infants and childrens clothing, namely, layettes, cloth bibs, slippers, sleepwear, underwear, rompers, shorts, shirts, coveralls, pants, socks, booties.
	August 5, 1997	2085471	Providing information in the field of fashion, fragrance, lifestyle and other topics of general interest by means of a global computer network.
	April 19, 1988	1485359	Mens', womens', childrens' and athletic shoes

TRADEMARK	APP/ REG. DATE	APP/ REG. NO.	GOODS/SERVICES
	October 12, 1982	1212060	Cologne, aftershave, aftershave balm, antiperspirant, toilet soap, toilet water

13. PRL markets and sells goods bearing the Polo Player Mark throughout the world and in the United States from approximately 200 PRL retail stores, as well as most major department and fine retail stores, including Bloomingdale's, Saks, Nordstrom's, Bergdorf Goodman, Macy's, Lord & Taylor, Belk, Dillard's, and Neiman Marcus.

14. PRL also sells its goods on its website located at <www.ralphlauren.com> (the "PRL Website"), and through other online retailers, including, but not limited to, Nordstroms.com, Macys.com and Bloomingdales.com.

15. For over 40 years PRL has built its brands based on quality, success, integrity and a wholesome American lifestyle. PRL's advertisements are specifically designed to evoke these qualities and feature, *inter alia*, clean cut models and children engaged in healthy activities. As a result, PRL and the symbols and marks that are used to identify its goods in the market place have become an American phenomenon in the same vain as apple pie and baseball. PRL has made a substantial investment solidifying this image in the public square in the promotion of its goods that bear the Polo Player Mark.

16. In the course of becoming one of the most recognized brands in the United States, PRL has expended significant resources to protect the strength, goodwill and value of the Polo Player Mark.

17. PRL has expended significant time, effort, and money in advertising and promoting the goods and services sold under the Polo Player Mark in trade publications, magazines of general circulation, television ads, billboards, and the internet, as well as, through sports events sponsorship and authorized retailers.

18. PRL's goods and services marketed under the Polo Player Mark have enjoyed widespread and unsolicited media coverage, in print, on television and the Internet. PRL and its founder, Ralph Lauren, have received consistent recognition for the exceptional quality and design of the goods that bear the Polo Player Mark -- which has heightened consumer awareness of PRL's goods and their quality.

19. In 2007, PRL celebrated its fortieth anniversary and several of the most widely circulated magazines paid homage to man and company they deem to be an American icon. For example, an article from *The New York Times Style Magazine* in 2007, emphasizes the lasting impression that PRL's advertising and promotional campaign has had on the American public, as the author himself noted in comparing the fame of the Polo Player Mark to the Walt Disney's trademarks, "[PRL's] logo, a jaunty equestrian with a cocked polo mallet, is almost as recognizable . . . as the American Flag". Fortune magazine reiterates this sentiment, stating, "Polo is bigger than house names like Tiffany and Saks".

20. As a result, the Polo Player Mark is famous among the public and the trade as denoting the source of high-quality goods.

COUNT I **LIKELIHOOD OF CONFUSION**

21. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 20 herein.

22. The Polo Player Mark is famous in the United States and through out the world.

23. PRL commenced use of Polo Player Mark well before Applicant filed the Application and or commenced use of Applicant's Mark in commerce.

24. Applicant's Mark is similar to the Polo Player Mark in sight, sound, connotation and overall commercial impression.

25. Applicant's Mark incorporates the Polo Player Symbol.

26. The goods identified in the Application are identical or similar and or related to the goods with which PRL is using the Polo Player Mark and or within PRL's zone of natural expansion.

27. The goods identified in the Application are identical or similar and or related to the goods with which the Polo Player Mark is registered.

28. Registration of Applicant's Mark is likely to cause confusion, mistake, or deception as to the source of Applicant's goods and is likely to falsely suggest a common association, sponsorship or origin of said goods between Applicant and PRL.

COUNT II **DILUTION**

29. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 28 herein.

30. Through PRL's extensive advertisement and promotion and substantial sales, the Polo Player Mark has become famous.

31. Upon information and belief, any use by Applicant of Applicant's Mark has occurred after the Polo Player Mark became famous.

32. Applicant's Mark is likely to blur and or tarnish the positive associations of the Polo Player Mark.

CERTIFICATE OF SERVICE

I hereby certify that on this 3rd of December, 2010, the foregoing NOTICE OF OPPOSITION was served upon Applicant by delivering same to Applicant's counsel of record, via First Class Mail:

PATRICK M. TORRE
KING AND SCHICKLI, PLLC
247 N BROADWAY
LEXINGTON, KY 40507-1058

/oaf/
Orrin A. Falby